REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-23 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,671,280 to Rosen, in view of U.S. Patent 6,119,227 to Mao. This rejection is respectfully traversed.

Rosen discloses a system for commercial payments using trusted agents. In particular, Figure 1 shows a customer trusted agent 2 having its money module 6 communicating with a merchant trusted agent 4 having its money module 6. Figure 6 illustrates a configuration for commercial money module payments. As stated in the first paragraph of the Summary of the Invention, the electronic commercial payments are made from the payer to the payee without any intermediary. Indeed, the first of the Rosen invention states:

> It is an object of the present to provide a secure system using trusted agents that enables electronic commercial payments from payer to payee without any intermediaries.

Column 2, lines 16-19. Independent claims 1 and 12 recite, not only a customer agent and a merchant agent, but also an account manager and a mediating trusted agent.

It is difficult to understand just by referring to a figure "and associated text," (the format employed by the Examiner in the rejection), what element in Rosen or Mao is being identified for a particular claim recitation. If the Examiner elects to maintain this or some other prior art rejection, the Examiner is respectfully requested to identify for

each claim recitation a particular element by reference number from the prior art reference. For example, the Examiner refers to Figure 1 as allegedly showing the claimed "customer account manager receiving an initiation message sent from said customer agent, said message including data for registration of said customer agent and order information." Review of Figure 1 simply shows exchange of remittance advice and a ticket between a customer trusted agent and a merchant trusted agent. It is not evident where a customer account manager is shown or described. There is certainly no initiation message shown in Figure 1—let alone initiation message including registration and order information.

The Examiner contends that the recitation, "said customer account manager providing said customer agent with account data during a trading session being established between said customer agent and said merchant agent over the networks" is illustrated in Figure 4. Figure 4 shows a transaction device that relates to either the merchant's trusted agent (MTA) or the customer's trusted agent (CTA). See column 5, lines 15-24. There is nothing in Figure 4 or the description of Figure 4 in column 5 showing or describing establishing a trading session or a customer account manager providing a customer agent with account data during establishment of a trading session.

The Examiner contends that Figures 5a-5d and associated text show the feature of "said customer account manager amending and forwarding said initiation message to said mediating trusted agent for registration of said customer." Where in Figures 5a-d or in the associated text is there a customer account manager "amending and forwarding said

initiation message to said mediating trusted agent for registration of said customer?" What message corresponds to the initiation message? Where is that message amended? Where is the mediating trusted agent?

The Examiner states that Figure 6 and associated text show "said customer account manager delivering a deposit to said mediating trusted agent." First, it is unclear where any mediating trusted agent is shown in Figure 6. There is certainly no description of delivering a deposit to a mediating trusted agent in column 7, lines 24-49. The same deficiencies exist for the claim recitation, "said mediating trusted agent sending an information message including said deposit to said merchant agent," to which the Examiner also refers to column 6 and associated text.

Regarding the last recitation of claim 1, the Examiner refers to Figures 7a and 7b and associated text. These figures show an Abort subroutine and a Commit subroutine. A review of the associated text for the Abort subroutine fails to reveal where a determination is made that the value of at least one purchase equals or exceeds the value of the deposit.

Although the Examiner implies that a trusted intermediary is taught by Rosen in various bullet points set forth on pages 3 and 4 of the Office Action, the Examiner nevertheless admits at the bottom of page 4, that "Rosen does not disclose the use of a trusted intermediary." In an attempt to remedy this admitted deficiency, the Examiner relies upon the teachings of Mao, and in particular, on Figure 2. Figure 2 shows a client customer C coupled to a merchant M and to a financial intermediary F via a network.

Even though Mao describes an intermediary, Mao fails to disclose or suggest a mediating trusted agent for handling a deposit for one or more purchases. Accordingly, even if the combination of Rosen and Mao were accepted, (for purposes of argument only), neither reference teaches using a mediating trusted agent for handling the deposit by the customer.

In addition, neither Rosen nor Mao disclose or suggest stopping the trading session when the value of at least one purchase equals or exceeds the value of the deposit. In addition, the Examiner failed to show where Mao discloses the claim features noted above as not being apparent from the Examiner's application of Rosen.

In addition to the combination failing to teach all the independent claim features, the obviousness rejection must also be withdrawn because the combination of Rosen and Mao is legally improper. Black letter law requires that any obviousness rejection show a motivation or suggestion from the prior art to make the combination. See *In re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998). A proper motivation to combine requires an appreciation of the desirability of making the combination—not simply the feasibility of making the combination. See *Winner Int'l Royalty v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

In this case, there is evidence that the combination is not desirable coupled with an explicit teaching in Rosen that an intermediary, such as that described in Mao, should not be used. Indeed, the primary object of the invention in Rosen, (column 2, lines 16-18), states that:

> It is an object of the present invention to provide a secure system using trusted agents that enables electronic commercial payments from payer to payee *without any intermediaries*. (Emphasis added).

Thus, Rosen clearly *teaches away* from the combination proposed by the Examiner. The Federal Circuit has stated that a proposed modification that renders the prior art in operable for its intended purpose is inappropriate for an obviousness inquiry. *In re Fritch, 972 F.2d 1260, 1265-1266 (Fed. Cir. 1992).* The Examiner's modification of Rosen using Mao's intermediary renders Rosen inoperable to meet Rosen's intended objectives. The attempted combination is improper and must be withdrawn.

The application is therefore in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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